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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,253	12/22/2003	Dustin W. Carr	Carr 8-4-5	4460

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EXAMINER

DOAN, JENNIFER

ART UNIT PAPER NUMBER

2874

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/743,253	Applicant(s) CARR ET AL.	
	Examiner Jennifer Doan	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,9,11-13,19,20,22 and 24 is/are rejected.
- 7) ☒ Claim(s) 2-7,10,14-18,21 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>122203 & 060305</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The prior art documents submitted by applicant in the Information Disclosure Statements filed on 12/22/03 and 06/03/05, have all been considered and made of record (note the attached copy of form PTO-1449).

Drawings

2. The drawings, filed on 12/22/03, are accepted.

Specification

3. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 11-13 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (U.S. Patent 5,864,641).

With respect to claims 1, 11-13 and 24, Murphy et al. (figures 1-3) disclose a method and a device, comprising an optical waveguide (10) having a first grating (40), wherein at least a portion of the waveguide has a functional layer adapted to bind an analyte (column 4, lines 35-40); and when the analyte binds to the functional layer, the binding changes optical characteristics of the waveguide; wherein the first grating is a Bragg grating (column 5, lines 3-10); further transmitting light through an optical waveguide having a first grating; and measuring the transmitted light using a photo-detector (column 2, lines 40-43).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 8, 9, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. (as cited above) in view of Cooper et al. (U.S. 2003/0092034 A1).

With respect to claims 8, 19 and 22, Murphy et al. substantially disclose the device comprising a section of the resonator has a functional layer adapted to bind an analyte, wherein the optical characteristics of the resonator change, when the analyte binds to the functional layer (column 7, lines 1-5).

Murphy et al. do not disclose a device comprising a Mach-zehnder interferometer (MZI) having two arms, wherein one arm has an optical waveguide.

However, Cooper et al. (paragraph [0107]) disclose the device comprising a Mach-zehnder interferometer (MZI) having two arms, wherein one arm has an optical waveguide to low the signal noise (paragraph [0119]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Murphy to have Mach-zehnder interferometer (MZI) having two arms, wherein one arm has an optical waveguide (accordance with the teaching of Cooper et al.) for the purpose of reducing the signal noise.

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With respect to claims 9 and 20, Murphy et al. (figure 1) disclose the device, wherein the optical waveguide has a second grating and the first and second gratings form an optical resonator (column 7, lines 1-5).

Allowable Subject Matter

9. Claims 2-7, 10, 14 -18, 21 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose or reasonably suggest the device, wherein a plurality of grooves in the optical waveguide form the first grating; and at least some of the grooves are covered by the functional layer as recited in claims 2 and 14; wherein each grating has an optical reflection band characterized by a center wavelength; and at least two gratings have different reflection bands as recited in claims 4 and 16 and further the binding changes a differential phase shift as recited in claims 10, 21 and 23.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Doan whose telephone number is (571) 272-2346. The examiner can normally be reached on Monday to Thursday from 6:00 am to 3:30 pm, second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Doan

Patent examiner

September 27, 2005